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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,157	04/24/2001	Yoshihiko Watanabe	35.C15213	3428

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FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

HUNTSINGER, PETER K

ART UNIT PAPER NUMBER

2625

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/840,157

Applicant(s)

WATANABE ET AL.

Examiner

Peter K. Huntsinger

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/14/05 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed 10/14/05 have been fully considered but they are not persuasive.

The applicant argues in essence on page 2 of the response that:

#### **Kolls charges for a particular service, not for use of application software**

a. Kolls discloses a vending machine, such as PC 102/630 that can rely on services such as software device usage count and charges for access to program applications (col. 6-7, lines 63-67, 1-5).

### ***Claim Objections***

3. Claims 28, 33, and 38 are objected to because of the following informalities: The phrase "notifying an accounting sever" should be replaced with "notifying an accounting server." Appropriate correction is required.

4. Claims 27, 32, and 37 are objected to because of the following informalities: The phrase "wherein the file is formed using the application by a client apparatus" should be replaced with " wherein the file is generated using the application software by a client apparatus." Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 24-26, 28-31, 33-36, and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Kolls U.S. Patent 6,615,183.

Referring to claims 24, 29, and 34, Kolls discloses a file outputting system, method, and program comprising: generating means for generating a file by using an application software (col. 6-7, lines 63-67, 1-5); output processing means for executing output processing on the generated file (col. 6-7, lines 63-67, 1-5); output log recording means for, in response to the execution of the output processing, recording an amount of output product obtained through the output processing (60 of Fig. 1, col. 5, lines 19-21); and calculating means for calculating a charge for use of the application software

Art Unit: 2624

on the basis of the amount of the output product, recorded by said output log recording means (70 of Fig. 1, col. 5, lines 22-37). Kolls discloses providing copying and faxing services, which would require generating a file.

Referring to claims 25, 30, and 35, Kolls discloses unit price storing means for storing a unit price of the application (col. 6-7, lines 63-67, 1-5), wherein said calculating means calculates the charge for use of the application on the basis of the unit price (60 of Fig. 1, col. 5, lines 19-21).

Referring to claims 26, 31, and 36, Kolls discloses wherein the output processing includes at least one of facsimile transmission, printing, and e-mail transmission (col. 6, lines 63-67).

Referring to claims 28, 33, and 38, Kolls discloses notifying means for notifying an accounting server which effects accounting processing, of the calculated charge for use of the application (col. 36, lines 54-61).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 27, 32, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls U.S. Patent 6,615,183 as applied to claims 24, 29, and 34 above, and further in view of Crawford U.S. Patent 5,771,354.

Referring to claims 27, 32, and 37 Kolls discloses generating a file by using application software but does not disclose expressly transmitting the file to a server. Crawford discloses a file is formed using an application by a client apparatus connected to a network (col. 12-13, lines 59-67, 1-7), and then transmitted to a file server apparatus which includes said file storing means (col. 58, lines 8-17). Kolls and Crawford are in the same field of service vending systems. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to offer online storage services in the vending system of Kolls. The motivation for doing so would have been to provide a service to customers desiring to backup files. Therefore, it would have been obvious to combine Crawford with Kolls to obtain the invention as specified in claims 27, 32, and 37.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571)272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PKH

A handwritten signature in black ink, appearing to be 'PKH' followed by a stylized flourish.A handwritten signature in black ink, appearing to be 'KAWilliams'.

**KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER**